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Dieter Gansert

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REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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NEW YORK, NY 10022-7650

EXAMINER

SCHATZ, CHRISTOPHER T

ART UNIT

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1791

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/542,212  | <b>Applicant(s)</b><br>GANSERT, DIETER |  |
|                              | <b>Examiner</b><br>CHRISTOPHER SCHATZ | <b>Art Unit</b><br>1791                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 26-50 is/are pending in the application.
- 4a) Of the above claim(s) 26-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/14/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II in the reply filed on October 6, 2008 is acknowledged. The traversal is on the ground(s) that the technical features shared among the two groups make a contribution over the prior art and thus qualify as special technical features. The applicant's have amended the independent claims of each group and thus changed the scope of the claims. As noted in the rejections below, the technical features shared by the two Groups still do not define a contribution over the prior art. Thus, the two Groups do not share any special technical features.

The requirement is still deemed proper and is therefore made FINAL.

Claims 26-40 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 41 and 44-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 41, lines 8-9 refer to "a guide plane". It is unclear which of the two guide planes the applicant is referring to. It is recommended that the applicant replace "a guide plane" with "the guide planes".

Claims 44 and 46 refer to "the folding machine". There is insufficient antecedent basis for this term in the claims. It is recommended that the applicant replace "the folding machine" with "a folding machine".

Claim 45 recites the limitation "wherein the feeder for the cover sheet is arranged at the guide plane adjacent to the guide plane". It is unclear which guide plane the applicant is referring to. It is recommended that the applicant change the claim to read "at the lower guide plane adjacent said lower guide plane".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 41-43 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Honegger.

Honegger discloses a device capable of producing a brochure comprising at least one sheet feed (any of P.1-P.8); a joining means supply device for applying joining means 15; a joining device for joining a cover sheet to at least one contents sheet; and a folding device (the disclosure of a folding step implicitly requires a folding

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device after cutter 17); two guide planes (planes defined by the two rollers on top of any of the sheets P.1-P.8 fed from feeders 10.1-10.8) lying one above the other at a distance from one another being provided in the vicinity of the folding device for separate placement of a contents sheet and a cover sheet in a guide plane, respectively; and said folding device being simultaneously a joining device so that the sheets can be joined during folding (figure 3). The applicant should note that folding device can also function as a joining device because the step of folding necessarily requires that sheets be pressed against each other at the area where the sheets are joined.

As to claim 42, the guide plane for a contents sheet cooperates with a feeder. The spools disclosed by the reference feed the guide planes. As to claim 43, the spools also feed the guide plane(s) for the contents sheets. As to claim 45, the cover sheet feeder is arranged at the guide plane and adjacent to the lower guide plane.

6. Claims 41-46 are rejected under 35 U.S.C. 102(b) as being anticipated by DeAngelis (US 5749567).

As to claim 41, DeAngelis discloses a device capable of producing a brochure comprising at least one sheet feed (any of NP1-NP3); a joining means supply device 58a for applying joining means; a joining device for joining a cover sheet to at least one contents sheet; and a folding device (figure 4, column 6, lines 50-65); two guide planes lying one above the other at a distance from one another being provided in the vicinity of the folding device for separate placement of a contents sheet and a cover sheet in a guide plane (figure 1), respectively; and said folding device being simultaneously a

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joining device so that the sheets can be joined during folding (figures 1b and 3; column 6, line 50 - column 7, line 25). The applicant should note that sheet c feed from NP3 in figure 1 is conveyed along a guide plane after it passes by roller 40. This guide plane lies above the guide plane for the any of sheets NP1-NP3 as shown in figure 1.

As to claims 42-45, DeAngelis discloses a device wherein the guide plane for the cover sheet or contents sheet cooperates with a folding machine or with a feeder and can be supplied by the latter with a contents or a cover sheet in immediate succession. The feeder for any one of sheets NP1-NP3 or c guides the sheets to the guide plane(s) and is arranged adjacent to the upper or lower guide plane(s). Any one of the sheets NP1-NP3 can function as a cover sheet or contents sheet and the feeder for each of the sheets is arranged adjacent the lower guide plane(s) (figure 1). As to claim 46, the feeder for a contents sheet and the feeder for a cover sheet are arranged at opposite sides of the guide planes and capable of transporting a cover sheet and a contents sheet in opposite directions (figure 1).

7. Claims 41-43, 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Osako et al. (US 5678813).

As to claim 41, Osako discloses a device capable of producing a brochure comprising at least one sheet feed 113, 119, 124; a joining means supply device 123 for applying joining means; a joining device 125, 128 for joining a cover sheet to at least one contents sheet; and a folding device 125, 128; two guide planes lying one above the other at a distance from one another being provided in the vicinity of the folding device for separate placement of a contents sheet and a cover sheet in a guide plane

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(guide planes defined by conveyors 11 and 117), respectively; and said folding device being simultaneously a joining device so that the sheets can be joined during folding (figure 8, column 9, line 21 - column 10, line 50; column 7, lines 51-66; figure 5).

As to claims 42 and 43, the reference discloses respective feeders 113, 124 or 128 cooperating with respective guide planes for a cover and contents sheet, wherein said respective feeders supply each respective plane with its respective sheet in immediate succession. As to claim 47, the reference discloses stops 3 provided at each guide plane, said stops capable of being adjusted depending upon a sheet dimension.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osako as applied to claim 41 above, and further in view of Graushar et al. (US 5662448).

Osako discloses the limitations of claim 41 as discussed above, but it is unclear if the reference discloses a device with monitoring devices for detecting deficient qualities in the vicinity of the folding device. Graushar discloses a device for joining a cover sheet to a contents sheet comprising a folding device capable of folding and joining the contents sheet to the cover sheet, said device further comprising monitoring devices for

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detecting deficient quality in the vicinity of a folding device (column 1, line 65 - column 2, line 11; column 3, lines 12-25). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to modify the device of Osako by providing a monitoring device for detecting deficient quality in the vicinity of the folding device as taught by Graushar above as such a modification allows the device to produce a products with few defects.

10. Claims 49 and 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osako as applied to claim 41 above, and further in view of Miaskoff et al. (US 3816866).

Osako discloses the limitation of claim 41 as discussed above, but it is unclear if the reference discloses a sorting device for removing defective cover and contents sheets from the vicinity of the folding device. Miaskoff discloses a device for monitoring the quality of a product comprising a cover sheet formed over a contents sheets, said device being capable of sorting out defective sheets and removing them (abstract). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the apparatus of Osako by providing a sorting device capable of sorting out defective sheets and removing them as taught by Miaskoff above because such a modification increases the quality of the product produced by the device.

As to claim 50, Miaskoff discloses a good/bad detection device (abstract).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER SCHATZ whose telephone number is



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571-272-6038. The examiner can normally be reached on Monday through Friday 9 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRISTOPHER SCHATZ/  
Examiner, Art Unit 1791

/Justin R Fischer/  
Primary Examiner, Art Unit 1791